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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,849	11/19/2001	Jonathan J. Hull	015358-007300US	3259

20350 7590 07/13/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
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EXAMINER

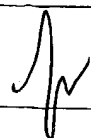
BAUTISTA, XIOMARA L

ART UNIT PAPER NUMBER

2179

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/001,849	Applicant(s) HULL ET AL.	
	Examiner X L Bautista	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/5/02&7/22/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: "when printed on one the more pages" (line 9) should be changed to --when printed on the one or more pages--. Correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 12-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-17 recite a paper document. These claims don not truly fit any of the four statutory classes of invention, "process, machine, manufacture, or composition matter." They are not even held upon a computer-readable medium, as discussed in the Guidelines for examination, 1995. The claims recite nothing more than information, having some potential use to a computer capable of reading and interpreting them, in a manner analogous to the information content of printed matter, long held to be non-statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claim 1, 4-7, 10-15, 17, 18, 21-24, 27-29, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by *Schelling et al* (US 5,706,097).**

Claims 1, 11, 12, 28, 29, 32, and 33:

Schelling discloses a method for generating an index print (paper document) for a multimedia document storing multimedia information including video, audio, graphic, and text information. A user may select representations of the information

for retrieving information of his interest. Schelling teaches identifiers (clues) that help the user to identify relevant information. Schelling teaches that users may print the multimedia information on a paper document (abstract; col. 1, lines 58-67; col. 2, lines 1-14, 43-67; col. 3, lines 1-25; col. 4, lines 2-7).

Claims 4 and 21:

See claim 1. Schelling teaches a method of generating an index print (printable representation) for a multimedia document having multimedia information (text, audio, video), (abstract; col. 1, lines 58-67; col. 2, lines 1-20). The method has layout information for printing the printable representation of the first and second type on a paper medium (col. 3, lines 1-40).

Claims 5 and 22:

See claim 4. Schelling teaches that the topic of interest (audio, video, text, etc.) is annotated using different styles (type indicators), (figs. 1, 4, 5).

Claims 6 and 23:

See claim 1. Schelling teaches an indicator icon that indicates files containing sound and a text message describing the data file. Shelling illustrates text relating to (fig. 1) a sound recording of a person's (i.e. Grandma's) voice (col. 2, lines 62-67; col. 3, lines 10-29).

Claims 7 and 24:

See claim 6. Schelling teaches that the system analyzes the objects (text, image, etc.), retrieves and displays the information (fig. 1; col. 2, lines 43-67; col. 3, lines 1-40; col. 4, lines 57-67; col. 5, lines 1-14).

Claims 10 and 27:

See claim 7. Schelling teaches an index print having video frames extracted from video information and text information extracted from

Claims 13-15 and 17:

Schelling teaches indicators for annotating the multimedia information (col. 2, lines 43-67; col. 3, lines 1-40; col. 4, lines 57-67; col. 5, lines 1-16).

Claim 18:

See claim 1. Schelling teaches a computer system having a processor, display, and memory (figs. 2 and 3; col. 3, lines 40-67; col. 4, lines 1-7).

Claim 30:

See claim 1. Schelling teaches an indicator icon that indicates files containing sound and a text message describing the data file. Shelling illustrates text relating to (fig. 1) a sound recording (audio information) of a person's (i.e. Grandma's) voice (col. 2, lines 62-67; col. 3, lines 10-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 3, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling and Nielsen et al* (US 6,055,542).**

Claims 2 and 19:

See claim 1. Schelling does not teach that user input identifying a concept of interest is stored in a user profile. However, Nielsen discloses a system and method for allowing a user to create an interest profile for finding information of interest within a document. Nielsen explains that once the profile is created, it may be used on any document or web page to sort the information on the page according to the user's interests; once sorted, the information is displayed to the user (abstract; col. 1, lines 59-67; col. 2, lines 10-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schelling's system of retrieving and displaying information to include Nielsen's teaching of creating an interest profile because as Nielsen

explains, it allows the user to view the points of interest without having to search the entire document.

Claims 3 and 20:

See claim 1. Schelling teaches printing a matter descriptor such as a title identifying the subject matter of the data file (col. 5, lines 1-3). Schelling does not teach a relevance indicator for indicating a degree of relevance of the multimedia information. However, Nielsen teaches an interest profile that can include additional data such as relative importance (weights); points of interest are sorted according to relevancy and are presented into the document as links (abstract; col. 1, lines 50-67; col. 2, lines 1-9). Thus, it would have been obvious to one ordinarily skilled in the art at the time of invention to include Nielsen's teaching of indicating a degree of relevancy in Schelling's multimedia document because as Nielsen says, it allows the user to quickly spot the areas of interest within a document and move to a desired point of interest within the document or page. the document (col. 4, lines 57-67; col. 5, lines 13-14).

8. Claims 8, 9, 16, 25, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling and Gibbon et al* (US 6,098,082).

Claims 8, 9, 25, and 26:

See claim 1. Schelling does not teach that the multimedia document includes printed closed-caption text information. However, Gibbon discloses a method for providing a compressed rendition of a video program in a format suitable for electronic searching and retrieval on the WWW. Gibbon teaches pictorial transcripts that are compact representations of video programs which are automatically generated by selecting representative frames or images from the video program and combining them with a second media component such as audio or text which is associated with each representative frame (abstract; col. 1, lines 55-67; col. 2, lines 1-15; col. 3, lines 10-15). Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22). Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Schilling to include Gibbon's teaching of printing closed-caption text because it provides a printable visual presentation of the sound associated with the image (frame) of interest; therefore, close captioning is not only visible on a TV receiver designed to display it but it is also visible when being printed on paper.

Claims 16 and 31:

See claim 8. Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22).

Conclusion

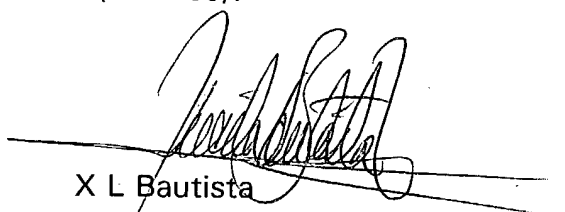
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X L Bautista whose telephone number is (703) 305-3921. The examiner can normally be reached on Monday-Thursday (8:00-18:00), Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



X L Bautista
Patent Examiner
Art Unit 2173

xlb
21 June 2004